

Remarks

The Office Action dated February 12, 2007 and made final has been carefully reviewed and the foregoing amendment and following remarks have been made in consequence thereof.

Claims 1-35 and 37-46 are now pending in this application. Claims 1-35 and 37-46 stand rejected.

Applicant and the undersigned wish to express their appreciation to Examiner Blair for the courtesies he extended during a telephone interview that occurred on June 25, 2007. During the interview, the Office Action dated February 12, 2007 was discussed. In addition, the undersigned discussed the differences between the present invention and Hull et al., U.S. Patent No. 6,704,118. For example, the undersigned pointed out that Hull does not describe or suggest triggering tasks to be performed as part of a workflow process based on the content extracted from at least one of the network email and the at least one enclosure included with the network email, wherein triggering tasks includes at least one of prompting the user to perform a business task relating to the content of the email. Rather, Hull describes automatic archiving of email documents. Applicant submits that automatic archiving of emails does not describe or teach triggering tasks to be performed as part of a workflow process based on the content extracted from at least one of the network email and the at least one enclosure included with the network email, wherein triggering tasks includes at least one of prompting the user to perform a business task relating to the content of the email.

Although no agreement was reached with respect to the patentability of the claims in the present case, the Examiner agreed to fully consider Applicant's arguments. The foregoing Amendment has been made in consequence of the Examiner Interview.

The rejection of Claims 1-35 and 37-46 under 35 U.S.C. § 103(a) as being unpatentable over Hull et al. (U.S. Patent No. 6,704,118) ("Hull") in view of Black et al. (U.S. Patent Publication No. 2002/0059317, now U.S. Patent No. 7,103,602) ("Black") and further in view of Peach (U.S. Patent Publication No. 2001/0049611) is respectfully traversed.

Preliminarily, Applicant respectfully traverses the assertion in the response to arguments section of the Office Action dated February 12, 2007 that “Hull and Black references show that the techniques claimed by the applicant were well known at the time of the applicant invention.” Applicant respectfully submits that no combination of Hull and Black describe or suggest triggering tasks to be performed as part of a workflow process based on the content extracted from at least one of the network email and the at least one enclosure included with the network email, wherein triggering tasks includes at least one of prompting the user to perform a business task relating to the content of the email after storing the network email into the graphics database. Moreover, Applicant respectfully traverses the assertion that “archiving is considered as task.” The passage referenced in the Office Action is titled “Automatic Archiving of Email Documents” and describes email archival performed by software on an email hub, however, the contents of the email is not extracted to trigger a task based on the content and even if the email hub did extract the contents of the email the contents of the email could not be used to trigger the archival process because the archival process is already in progress processing the email.

Applicant further traverses the addition of Peach “to explicitly show the applicant’s argued claim amendment by showing that emails can be processed (paragraph 21), converted to single page images (paragraph 22), and the results can prompt a user to initiate a workflow (paragraph 25).” It is impermissible to use the claimed invention as an instruction manual or “template” to piece together isolated disclosures so that the claimed invention is rendered obvious. It appears to Applicant that the present rejection reflects an impermissible attempt to use the instant claims as a guide or roadmap in formulating the rejection using impermissible hindsight reconstruction of the invention. The United States Supreme Court has recently expressed concern regarding distortion caused by hindsight bias in an obviousness analysis, and notes that factfinders should be cautious of arguments reliant upon *ex post* reasoning. See KSR International Co. v. Teleflex, Inc., slip Opinion at page 17. The Supreme Court also explained that, following “common sense,” “familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *Id.* at page 16. Applicant respectfully submits that the teachings of Hull, Black, or Peach do not fit together like pieces of a puzzle, but rather are isolated disclosures, which have been picked and chosen in an attempt to deprecate the present

invention. Of course, such a combination is impermissible, and for this reason alone, Applicant requests that the Section 103 rejection be withdrawn.

None of the references cited in the Office Action point to a description within Hull, Black, or Peach of triggering tasks to be performed as part of a workflow process based on the content extracted from the network email or an enclosure included with the network email. The passages recited in the Office Action that purport to describe the claimed process do not describe the claimed elements. None of Hull, Black, or Peach describe analyzing the content of emails or attachments and triggering a workflow task based on the content extracted from the network email or an enclosure included with the network email. Hull at Column 8, lines 60-61 recites “[t]hus, every document that is emailed is also archived without further user input.” Applicant respectfully submits that archiving every document that is emailed can not fairly be equated with triggering tasks to be performed as part of a workflow process based on the content extracted from at least one of the network email and the at least one enclosure included with the network email as is claimed.

None of Hull, Black, or Peach describe loading the content of the network email into the graphics database accessible from the network. Rather, at the passage referenced in the Office Action, Hull describes that “[d]ocuments to be archived are received by a CFI (conversion of formats and indexing) module 902 from any one of digital copier 106, print server 104, or facsimile machine 110.” Hull only describes documents to be archived from any one of digital copier 106, print server 104, or facsimile machine 110 as being received by CFI module 902. Hull does not describe receiving emails to be archived from the email hub. Accordingly, none of Hull, Black, or Peach describe loading the content of the network email into the graphics database accessible from the network as is asserted in the Office Action.

Further, at paragraph [0046], Black describes that an operation 56 determines whether there is an attachment to an email data file and then associates the attachment to the email data a file. However, Black does not describe nor suggest determining whether the at least one enclosure is in a non-graphics image format.

Applicant respectfully submits that none of Hull, Black, or Peach describe or suggest the claimed invention. As discussed below, at least one of the differences between the cited references and the present invention is that none of Hull, Black, or Peach describe or suggest a method for managing email content that includes automatically extracting the content of the network email using an email induction server and triggering tasks to be performed as part of a workflow process based on the content extracted from at least one of the network email and the at least one enclosure included with the network email, wherein triggering tasks includes prompting the user to perform a business task.

Rather, Hull describes an automatic archiving system that makes document archiving largely transparent to the user. Documents scanned in, printed during the course of office equipment operation or emailed are automatically archived. For example, an office local area network (LAN) may interconnect a copier, a printer, a facsimile machine, and a document management workstation. Whenever, a document is copied, printed, or faxed, a document image is archived by the document management workstation without further user intervention.

Hull further describes email document archival as being performed by software on an email hub. The email hub software routes and delivers mail over networks. A configuration file can be configured so that the email hub sends a copy of every message sent and received by a user, including the origin and destination addresses and the date and time of transmission, to the document management workstation. Thus, every document that is emailed is also archived without further user input and the documents are only archived. Hull does not describe nor suggest triggering business tasks based on the content of the email.

Notably, Hull does not describe or suggest extracting content from the email and triggering tasks to be performed based on the extracted content, wherein triggering tasks includes prompting the user to perform a business task.

Black describes an automated data management system and method for logging, processing, and reporting a large volume of data having different file types, stored on different media, and/or run by different operating systems. The system is used for the purpose of document production in, for example, a lawsuit. The system includes a first server processor for

restoring a plurality of received data files, wherein the data files are capable of being different file types; a file organizing/categorizing processor for organizing the received data files based on a predetermined user list into a source directory structure and a destination directory structure; a file logging processor for logging the received data files into a database formed by the source and destination directory structures and identifying a file type of the received data files; a de-duplicate processor for calculating a Secure Hash Algorithm (SHA) value of the received data files to determine whether the received data files have duplicates and flagging duplicated data files in the database; an image conversion processor for converting the remaining data files into image files, respectively; and a second server processor for exporting the image files.

Black also describes generating an ordered output of the image files for a print shop. This step includes assigning a bates number to each page of the image files. Bates numbering is a common organizational method used by law firms to identify documents while litigating a case. Notably, as described in Black, the assigning of a bates number to a document or image file occurs without a review of the content of the file.

Furthermore, Black also describes generating slip sheets for the ordered output of the image files. Slip sheets help differentiate document breaks and are another common organizational tool used by law firms. Black does describe the slip sheet containing information gathered about the data file or information useful to a customer who reviews the report, such as a file name, a bates number, a date, a user name, an email folder, etc. But similar to the bates numbering, generating a slip sheet occurs without a review of the content of the file. In other words, both the bates numbering and slip sheets in Black occur automatically and without a review of the content of the file. For each new page a bates number is sequentially added, regardless of the content of the page, and for each new document a slip sheet is added, regardless of the content of the document, in order to separate the documents.

Peach merely describes an insurance agent entering information via an Internet connection regarding a potential client or a customer to obtain a quote on an insurance policy. The client's data is entered automatically into insurance industry standard forms. Completed forms may be compressed into a single file which may be transmitted to the requesting insurance agent as an email attachment or, may be made available for direct download from the server 102

by the agent. Notably, Peach does not describe nor suggest any automatic handling of emails or attachments, nor does Peach describe or suggest emails can be processed (paragraph 21). Rather, Peach only describes that remotely connected units 112 are connected over a network 114 to receive e-mail from the e-mail server 110. Peach also does not describe nor suggest converting emails to single page images (paragraph 22) as asserted in the Office Action. Rather, Peach describes that the application and policy data is then sent to formatting system 104 wherein the formatting system 102 formats application and policy data into industry-standard format, e.g., into completed ACORD forms. If the policy is not accepted in step 134, the completed forms are provided as uneditable image (e.g., a bitmap), portable document format (pdf) or Joint Photographic Experts Group jpeg) image files, but Peach does not describe nor suggest converting the content of the network email including the at least one enclosure having a non-graphics image format to a single page graphics image format. Moreover, the Office Action asserts that the results can prompt a user to initiate a workflow (paragraph 25), however, Peach describes that the agent retrieves the self-extracting file, either from visiting the FTP server and selecting the URL to download or, by opening e-mail and downloading the attachment. Then, the agent launches the self-extracting file, thereby, extracting and decompressing the ACORD forms. Applicant respectfully submits that simply emailing a self extracting file cannot fairly be equated with automatically extracting the content of the network email using the email induction server including analyzing the network email to determine whether the network email includes at least one enclosure, if the network email includes at least one enclosure, determining whether the at least one enclosure is in a non-graphics image format, and converting the content of the network email including the at least one enclosure having a non-graphics image format to a single page graphics image format.

Claim 1 recites a method for managing email content using an email server, an email induction server and a graphics database, wherein the email server, the email induction server and the graphics database are in communication through a network, the method includes “receiving at the email server an email via the network...electronically monitoring the network email received at the email server for email content...automatically extracting the content of the network email using the email induction server including...analyzing the network email to determine whether the network email includes at least one enclosure, if the network email

includes at least one enclosure, determining whether the at least one enclosure is in a non-graphics image format, and converting the content of the network email including the at least one enclosure having a non-graphics image format to a single page graphics image format...loading the content of the network email into the graphics database accessible from the network...and triggering tasks to be performed as part of a workflow process based on the content extracted from at least one of the network email and the at least one enclosure included with the network email, wherein triggering tasks includes at least one of prompting the user to perform a business task relating to the content of the email after storing the network email into the graphics database.”

None of Hull, Black, or Peach suggest or describe, alone or in combination, a method for managing email content as recited in Claim 1. More specifically, none of Hull, Black, or Peach suggest or describe, alone or in combination, a method for managing email content including automatically extracting content of the network email and triggering tasks to be performed as part of a workflow process based on the content extracted from at least one of the network email and the at least one enclosure included with the network email, wherein triggering tasks includes at least one of prompting the user to perform a business task relating to the content of the email after storing the network email into the graphics database.

Rather, Hull describes automatically archiving documents that are emailed, printed, or faxed, regardless of the content of the document, and Black simply describes an automated process for assigning a bates number to each page of the stored image files and for generating a slip sheet between the documents. No combination of Hull, Black, or Peach describe or suggest triggering tasks based on the content extracted from the email or enclosure, wherein triggering tasks includes prompting the user to perform a workflow activity.

Moreover, none of Hull, Black, or Peach suggest or describe, alone or in combination, converting the content of the network email including the at least one enclosure having a non-graphics image format to a single page graphics image format.

Applicant agrees with the assertion in the Office Action the Hull does not teach analyzing an email for an attachment and converting the attachment into a graphics image format. In

contrast to the present invention, Black simply describes that image conversion operation (72) starts with an operation (74) of selecting a new file type to convert the data files under the selected file type into image files. Next, a new data file among the data files having the same file type is selected in an operation (76). Then, the selected data file is converted into an image file in an operation (78). Next, the image file is stored in the file database to be reviewed in an operation (80). Further, at paragraph [0082], Black merely describes “converting the data or email file to an image file and storing the image file in the assigned user destination directory.” None of Hull, Black, or Peach describe or suggest converting the at least one enclosure having a non-graphics image format to a single page graphics image format. Accordingly, Applicant respectfully submits Claim 1 is patentable over Hull in view of Black, and further in view of Peach.

Claims 2-34 depend from independent Claim 1. When the recitations of Claims 2-34 are considered in combination with the recitations of Claim 1, Applicant submits that dependent Claims 2-34 likewise are patentable over Hull in view of Black, and further in view of Peach.

Independent Claim 35 recites a system for managing email content of a network, comprising “an email server configured to monitor incoming email of the network for content...a graphics database for storing data files...and an email induction server connected in communication with the email server and the graphics database through the network, the email induction server configured to: (a) automatically extract content from the email by...analyzing the email to determine whether the email includes at least one enclosure, and if the email includes at least one enclosure, determining whether the at least one enclosure is in a non-graphics image format, (b) convert the content of the email including the at least one enclosure having a non-graphics image to a single page graphics image, (c) load the content of the converted email to the graphics database accessible from the network, (d) trigger tasks to be performed as part of a workflow process based on the content extracted from at least one of the email and the at least one enclosure included with the email wherein the email induction server configured to prompt the user to perform a workflow activity relating to the content of the email after storing the network email into the graphics database.”

Claim 35 recites a system for managing email content of a network that includes an email induction server configured to perform steps essentially similar to those method steps recited in Claim 1. Thus, it is submitted that Claim 35 is patentable over Hull in view of Black, and further in view of Peach for at least the reasons that correspond to those given with respect to Claim 1.

Claims 37-41 depend from independent Claim 35. When the recitations of Claims 37-41 are considered in combination with the recitations of Claim 35, Applicant submits that dependent Claims 37-41 likewise are patentable over Hull in view of Black, and further in view of Peach.

Independent Claim 42 recites an email system for processing email for a network, the system including an email server configured to monitor incoming email of the network for content, a graphics database for storing data files, and an email induction server connected in communication with the email server and the graphics database through the network, the email induction server including application software configured to “analyze the email to determine whether the email includes at least one enclosure, if the email includes at least one enclosure, determine whether the at least one enclosure is in a non-graphics image format...extract content from the email...convert the content of the email including the at least one enclosure having a non-graphics image to a single page graphics image...load the content of the converted email to the graphics database accessible from the network...and trigger tasks to be performed as part of a workflow process based on the content extracted from at least one of the email and the at least one enclosure included with the email wherein the application software is configured to prompt the user to perform a workflow activity relating to the content of the email after storing the network email into the graphics database.”

Claim 42 recites a system for managing email content of a network that includes an email induction server including application software configured to perform steps essentially similar to those steps recited in Claims 1 and 35. Thus, it is submitted that Claim 42 is patentable over Hull in view of Black, and further in view of Peach for at least the reasons that correspond to those given with respect to Claims 1 and 35.

Claim 43 depends from independent Claim 42. When the recitations of Claim 43 are considered in combination with the recitations of Claim 42, Applicant submits that dependent Claim 42 likewise is patentable over Hull in view of Black, and further in view of Peach.

Independent Claim 44 recites a process for memorializing email content using an email server, an email induction server and a graphics database, wherein the email server, the email induction server and the graphics database are in communication through a network, the process including “communicating email from a computer to the email server, wherein the email includes data describing an insurance claim submitted for processing...automatically extracting the content of the email including the insurance claim data using the email induction server including: analyzing the email to determine whether the email includes at least one enclosure, if the email includes at least one enclosure, determining whether the at least one enclosure is in a non-graphics image format, and converting content of the email including the at least one enclosure having a non-graphics image format to one or more single page graphic images for storage within the graphics database in response to receiving the email at the email server...automatically communicating acknowledgment to the email server that the content is graphically memorialized...and triggering insurance claim processing tasks to be performed to process the submitted insurance claim data based on the content extracted from at least one of the email and the at least one enclosure included with the email wherein triggering insurance claim processing tasks includes prompting the user to further process the insurance claim.”

Claim 44 recites a process for memorializing email content that performs steps essentially similar to those steps recited in Claims 1, 35, and 42. Thus, it is submitted that Claim 44 is patentable over Hull in view of Black, and further in view of Peach for at least the reasons that correspond to those given with respect to Claims 1, 35 and 42.

Moreover, Claim 44 recites “communicating email from a computer to the email server, wherein the email includes data describing an insurance claim submitted for processing...automatically extracting the content of the email including the insurance claim data using the email induction server including...triggering insurance claim processing tasks to be performed to process the submitted insurance claim data based on the content extracted from at least one of the email and the at least one enclosure included with the email wherein triggering

insurance claim processing tasks includes prompting the user to further process the insurance claim.”

None of Hull, Black, or Peach suggest or describe, alone or in combination, a process for memorializing email content as recited in Claim 44. More specifically, none of Hull, Black, or Peach suggest or describe, alone or in combination, a process for memorializing email content wherein the email includes data describing an insurance claim and the process includes automatically extracting the content of the email including the insurance claim data and triggering insurance claim processing tasks to be performed to process the submitted insurance claim data based on the content extracted wherein triggering insurance claim processing tasks includes prompting the user to further process the insurance claim.

Claims 45 and 46 depends from independent Claim 44. When the recitations of Claims 45 and 46 are considered in combination with the recitations of Claim 44, Applicant submits that dependent Claims 45 and 46 likewise are patentable over Hull in view of Black, and further in view of Peach.

For at least the reasons set forth above, Applicant respectfully requests that the rejection of Claims 1-35 and 37-46 under 35 U.S.C. § 103(a) be withdrawn.

In addition, Applicant respectfully submits that the Section 103 rejection of the presently pending claims is not a proper rejection. As is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. None of Hull, Black, or Peach considered alone or in combination, describe or suggest the claimed combination.

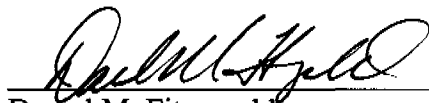
Applicant submits that the presently claimed invention is not obvious over Hull in view of Black, and further in view of Peach. The Office Action only offers the conclusory statement that “[i]t would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of the Hull-Black combination regarding the processing of emails with the teachings of Peach regarding an automated insurance workflow system that prompts a user because Peach provides an overview of that includes the more specific techniques taught by Hull and Black.” The United States Supreme Court has recently

held that obviousness rejections must be supported with “articulated reasoning with some rational underpinning to support the conclusion of obviousness.” See KSR International Co. v. Teleflex, Inc., slip Opinion at page 14. The present rejection does not appear to meet this standard as it reflects no articulate reasoning why the independent or dependent claims are believed to be obvious, but rather is stated in the form of a conclusion of obviousness. Applicant accordingly requests specific explanation and articulation regarding the reasoning and rational underpinning for any obviousness rejection of the claims. It is not believed that adequate reasons why the presently claimed invention is believed to be obvious have been provided on the present record.

It appears to Applicant that the present rejection reflects an impermissible attempt to use the instant claims as a guide or roadmap in formulating the rejection using impermissible hindsight reconstruction of the invention. The United States Supreme Court has recently expressed concern regarding distortion caused by hindsight bias in an obvious analysis, and notes that factfinders should be cautious of arguments reliant upon *ex post* reasoning. See KSR International Co. v. Teleflex, Inc., slip Opinion at page 17.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



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